

Notice of Allowability

Application No.

10/802,359

Examiner

William J. Allen

Applicant(s)

SILBERSTEIN ET AL.

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Examiner's Amendment and response filed 12/7/2006.

2. ☒ The allowed claim(s) is/are 21-40.

3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

5. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached

1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.

(b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date 20070212.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)

2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____

4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material


5. ☐ Notice of Informal Patent Application

6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 20070212.

7. ☒ Examiner's Amendment/Comment

8. ☒ Examiner's Statement of Reasons for Allowance

9. ☐ Other _____


MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

Art Unit: 3625



DETAILED ACTION

Prosecution History Summary

Claims 1-20 have been previously cancelled.

Claims 21-45 were pending per Applicant's amendment filed 12/07/2006.

Claims 41-45 have been canceled per the below Examiner's Amendment.

Claims 21-40 are allowed for at least the reasons below.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Matt Dennehy on 2/9/07.

Art Unit: 3625

The application has been amended as follows:

In the Claims

Claims 1-20 (Cancelled).

21. (Currently Amended) A method for selling jewelry to a customer, the customer acting as a gift giver, the method comprising the steps of:

providing a selection of rough stones to a customer;

informing the customer about available options on cuts and sizes of stones that may be yielded from the selection of rough stones;

allowing choosing, by the customer, ~~to choose~~ a specific rough stone from the selection of rough stones based on a specific available option chosen by the customer;

cutting the specific rough stone into at least two cut stones as per the specific available option chosen by the customer, the at least two cut stones including a major stone and at least one remainder stone;

selling the cut stones to the customer;

allowing presenting, by the customer, ~~to present~~ the cut stones to at least two recipients, whereby the customer and the recipients have a specific sentimental relationship, the cut stones yielded from the specific rough stone being symbolic of the sentimental relationship.

22. (Previously Presented) The method of selling jewelry as claimed in claim 21 wherein the customer and one of the recipients are same person.

Art Unit: 3625

23. (Previously Presented) The method of selling jewelry as claimed in claim 21 wherein the customer is a parent and the recipients are at least two children of the parent.

24. (Previously Presented) The method of selling jewelry as claimed in claim 21 wherein the customer is a grandparent and the recipients are at least two grandchildren of the grandparent.

25. (Previously Presented) The method of selling jewelry as claimed in claim 21 whereby the selection of rough stones have stones of different karat, color and clarity.

26. (Previously Presented) The method of selling jewelry as claimed in claim 21 further comprising the step of determining a cutting configuration for the specific rough stone.

27. (Previously Presented) The method of selling jewelry as claimed in claim 26 whereby the cutting configuration is any possible type of cut for a gemstone.

28. (Previously Presented) The method of claim 21 further comprising the step of: mounting the at least two stones to at least two pieces of jewelry, the pieces of jewelry being presented to the recipients.

29. (Previously Presented) The method of claim 22 wherein the specific sentimental relationship is husband and wife.

30. (Previously Presented) The method of claim 22 wherein the specific sentimental relationship is a life partner.

31. (Previously Presented) The method of claim 22 wherein the specific sentimental relationship is parent and child.

32. (Previously Presented) The method of claim 22 wherein the specific sentimental relationship is siblings.

33. (Previously Presented) The method of claim 22 wherein the specific sentimental relationship is persons engaged to be married.

34. (Previously Presented) The method of claim 21 wherein the step of providing a plurality of rough stones to a customer is presented over the Internet.

35. (Previously Presented) The method of claim 21 wherein the step of providing a plurality of rough stones to a customer is presented at a retail store.

36. (Previously Presented) The method of claim 21 wherein the step of providing a plurality of rough stones to a customer is presented in a catalogue.

37. (Previously Presented) The method of claim 21 wherein the specific rough stone is a diamond.

38. (Previously Presented) The method of claim 21 wherein the specific rough stone is a ruby.

39. (Previously Presented) The method of claim 21 wherein the specific rough stone is an emerald.

40. (Currently Amended) The method of claim + 21 wherein the specific rough stone is a sapphire.

Claims 41-45 (Cancelled).

ALLOWABLE SUBJECT MATTER

The following is an examiner's statement of reasons for allowance:

Regarding claim 21, the prior art made of record neither anticipates nor fairly and reasonably teaches "choosing, by the customer, a specific rough stone from the selection of rough stones based on a specific available option chosen by the customer and cutting the specific rough stone into at least two cut stones as per the specific available option chosen by the customer, the at least two cut stones including a major stone and at least one remainder stone".

Claims 22-40 depend from allowable claim 21 and are thereby allowable for at least the reasons above regarding claim 21.

The most remarkable prior art of record is CA 2343448 (listed as PTO 892 reference N) to Tcharnyl (herein referred to as CA234). CA234 teaches a new marketing principal for customized jewelry specifically directed to sets of two or more loose gemstones or jewelry articles containing gemstones. More specifically, CA 234 is relevant in that it provides a means for selling two or more gemstones (or jewelry articles containing two or more gemstones) that have been cut from the same rough stone in order to provide a higher emotional value to the article. Unlike the present application, CA 234 provides goods comprising two or more polished gemstones or other precious stones cut from the same rough stone. Though CA 234 does provide for the sentimental aspects of the instant application, it is clear that CA 234 is fundamentally different as it is not directed to the selection, by the customer, of a specific rough stone and having the stone cut according to a specific option designated by the customer.

US Patent/PG Pubs

- **US 20050197951 to Tolkowsky** teaches a method of selling polished gemstones or jewelry pieces set with polished gemstones, the piece of jewelry being accompanied with a rough stone which was part of the same unique piece of rough from which the polished gemstone was produced. Tolkowsky, however, does not anticipate or render obvious the above mentioned limitations.
- **US 5950178 to Borgato** teaches a data processing system storing data from sellers on stones to be sold based upon various characteristics such as weight, color, etc. Though Borgato teaches the selling of both cut and uncut stones to willing buyers, Borgato fails to anticipate or render obvious the above noted limitations.

Foreign Patent Documents

- **CA 2343448 to Tcharnyl** teaches a new principal in marketing jewelry including marketing gemstones or jewelry containing gemstones, wherein the gemstones originated from the same rough stone. Tcharnyl, however, fails to anticipate or render obvious the above noted limitations.
- **JP 01017605 to Freilich** teaches double-faced personal ornaments manufactured to hold rough or unfinished stones/jewelry pieces such as diamonds. Freilich, however, fails to anticipate or render obvious the above mentioned limitations.

Non-Patent Literature

- **PTO 892 reference U** teaches market analysis for diamond sales where high-end independent retailers and internet retailers outperformed the remainder of the market. PTO 892 U, however, fails to anticipate or render obvious the above noted limitations.
- **PTO 892 reference V** teaches the Atlantis ring, a wedding ring yielded from the same material and created in the same mold. PTO 892 V, however, fails to anticipate or render obvious the above noted limitations.
- **PTO 892 reference W** teaches the website BlueNile.com for selling customized jewelry articles. PTO 892 W is directed to the sale of pre-cut, cataloged stones and fails to anticipate or render obvious the above mentioned limitations.
- **PTO 892 reference X** teaches the lesbian lover ring, available in a two piece set as a wedding ring, promise ring, or the like. The two piece set is designed to fit together as a symbol of commitment. PTO 892 X, however, fails to anticipate or render obvious the above noted limitations.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Art Unit: 3625

Examiner's Comments

In the Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings submitted contain hand drawn elements and improper shading that may affect clarity once reproduced (see Fig. 2). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings.

Art Unit: 3625

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443.

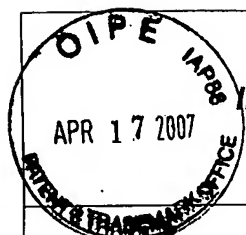
The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
February 12, 2007


MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600



Interview Summary

Application No.	Applicant(s)	
10/802,359	SILBERSTEIN ET AL.	
Examiner	Art Unit	
William J. Allen	3625	

All participants (applicant, applicant's representative, PTO personnel):

- (1) William J. Allen. (3) _____
(2) Matt Dennehy. (4) _____

Date of Interview: 09 February 2007.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____

Claim(s) discussed: 21-45.

Identification of prior art discussed: _____

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant was contacted to propose an Examiner's Amendment. Applicant approved entry of the Examiner Amendment on 2/9/2007..

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application file whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Notice of References Cited

Application/Control No.

10/802,359

Applicant(s)/Patent Under
Reexamination
SILBERSTEIN ET AL.

Examiner

William J. Allen

Art Unit

3625

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2005/0197951	09-2005	Tolkowsky, Jean-Paul	705/037
*	B	US-5,950,178	09-1999	Borgato, Sergio	705/37
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	CA 2343448	10-2002	CA	Tcharnyl	A44C 17/00
	O	JP 01017605	01-1989	Japan	Freilich	A44C 17/02
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	"De Beers: high-end independents, Web drove diamond jewelry sales in 2005". National Jeweler. March 16, 2006. [extracted from Dialog database 06-02-2007].
	V	www.atalntisring.com. Dec 16, 2003. [extracted from www.archive.org 25-05-2006]
	W	www.bluenile.com. 16 Feb 2003. [extracted from www.archive.org 21 October 2005.]
	X	www.moonstone-jewelry.com/lesbian-ring-511.html. 21 October 2002. [extracted from www.archive.org 24 October 2005]

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.